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Appl. No. 09/729,426

Response to Office Action dated October 7, 2004

**REMARKS**

Reconsideration and allowance of the subject patent application are respectfully requested.

An Information Disclosure Statement was filed on October 19, 2004. Applicant respectfully requests consideration of the information cited therein and return with the next office action of a PTO-1449 form initialed to evidence this consideration.

Applicants hereby affirm the election of claims 1-12 and 21 for prosecution on the merits. Applicant notes the identification of claims 23 and 24 as "linking claims" that link inventions I and II. Applicant requests that upon the allowance of these claims, the restriction requirement be withdrawn as noted in the office action.

The disclosure has been amended to correct various informalities including those noted on page 3 of the office action. Withdrawal of the objection to the disclosure is respectfully requested.

Applicant notes that amendments of a formal nature have been made to claims 1-24. These amendments are not made for reasons relating to patentability.

Claims 1, 2, 3 and 21 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Kurokawa *et al.* (U.S. Patent No. 5,887,088) in view of Leung *et al.* (U.S. Patent No. 5,877,963). Applicant respectfully traverses this rejection.

With respect to claim 1, the office action alleges that Kurokawa *et al.* discloses the claimed memory section, input section, control section and output section. Kurokawa *et al.* discloses a system in which an "instructive document" is marked by a user and thereafter scanned by an image scanner 9. The scanned image is then analyzed to detect the markings made by the user and inputs to an application are generated based on the detected markings. Form identification information is extracted from the scanned image and this "form ID" is used to retrieve analysis information for analyzing the meaning of the marks on the instructive document.

Applicant does not agree with the assertion in the office action that the "form ID" of Kurokawa *et al.* corresponds to an identification number as claimed. In Kurokawa *et al.*, the "form ID" is used to retrieve analysis information that enables the system to interpret certain

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marks made on an instructive document -- it is not used to retrieve a document for output by an output section. Any output in Kurokawa *et al.* is based on the marks on the instructive document. For example, the Kurokawa *et al.* specification describes requesting a list 111 of stored image data stored in a "Technical 2" category based on a marked instructive document. See, e.g., col. 15, line 37 *et seq.* Accordingly, the "form ID" of Kurokawa *et al.* does not correspond to the claimed identification number.

Further, Kurokawa *et al.* does not disclose an input section for receiving an image including an identification number of a document. In the office action, command receiving portion 31 of Kurokawa *et al.* is alleged to correspond to the claimed input section. However, there is no description in Kurokawa *et al.* of command receiving portion 31 receiving an image including an identification number. Instead, Kurokawa *et al.* describes that "...command receiving portion 31 audibly responds to a call which a user generates by operating push buttons of the FAX 16, the keys of the input section 7, or by clicking a mouse, receives the document number of an input instructive document, and sends the document number to the instructive document output portion." Kurokawa *et al.*, col. 9, lines 14-19. Kurokawa *et al.* further describes at col. 13, line 41 *et seq.* that the document number of an instructive document is input using the "DTMF" tones. There is no description of command receiving portion 31 of Kurokawa *et al.* receiving an image including an identification number as alleged in the office action.

Still further, Kurokawa *et al.* does not disclose a document obtaining section which obtains a document having an identification number matching that which was extracted from an input image. As explained above, Kurokawa *et al.* does not receive an image including an identification number of a document and thus contains no disclosure or suggestion of using an identification number extracted from such an image to obtain a document.

Consequently, Kurokawa *et al.* does not disclose (or even suggest) extracting an identification number from a received image and then using this extracted number to determine a document to be output. In addition, as acknowledged in the office action, Kurokawa *et al.* does not disclose the concept of the received image including summary information, nor of extracting this summary information and using it to determine whether a document obtained based on the extracted identification number should be output.

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*Leung et al.* is alleged to remedy the admitted deficiencies of *Kurokawa et al.* In particular, the office action references *Leung et al.*'s disclosure beginning at col. 10, line 53 relating to the location of a previously stored document. This portion of *Leung et al.* describes scanning in a document similar in type to a previously stored document. The system calculates a feature vector for the scanned in document (which the office action equates to the claimed summary information) and then compares the feature vectors of the previously stored documents with the calculated feature vector. Based upon the closest matches, the system locates suggested folders where the document may be found.

First, even assuming the feature vector is argued to constitute summary information, *Leung et al.* teaches using such purported summary information to locate possible matching documents, not to determine whether to output an already located document. Second, *Leung et al.* does not disclose or suggest providing the "feature vector" as part of an image supplied to an input section or extracting the "feature vector" from an image or using such an extracted "feature vector" to judge whether to output a document. As such, *Leung et al.* does not remedy the deficiencies of *Kurokawa et al.* and the combination of these two documents (even if proper) would not have resulted in the subject matter of claim 1.

In short, the proposed combination of *Kurokawa et al.* and *Leung et al.* fails to disclose or suggest an image including an identification number and summary information. Further, the proposed combination fails to disclose or suggest the input of such an image to an input section. Still further, there is no disclosure or suggestion in the *Kurokawa et al.* and *Leung et al.* documents of extracting an identification number and/or summary information from such an input image, using the extracted identification number to obtain a document and/or using the extracted summary information in a judging operation involving the obtained document.

In addition, the office action states that *Kurokawa et al.* and *Leung et al.* are combinable "because they are in the same problem area of document management." Applicant submits that this reason is insufficient by itself to provide the necessary motivation for combination. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify *Kurokawa et al.* based on *Leung et al.* Applicant submits that the motivation for the proposed combination is not found in the

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references or the knowledge of one of ordinary skill, but rather has been found improperly in Applicant's own disclosure.

For at least these reasons, Applicant respectfully submits that claim 1 and its dependent claims 2 and 3 are not rendered obvious by the proposed combination of Kurokawa *et al.* and Leung *et al.*

Independent claims 21 calls for a recording medium which stores a document management program which is used in a computer system including a memory section, an input section and an output section. The document management program instructs the computer to extract an identification number and summary information from an image received by the input section; to search for and obtain from the memory section a document having an identification number which corresponds to the extracted identification number; and to judge whether the extracted summary information is correct with respect to the obtained document to determine whether to output the obtained document via the output section. For reasons similar to those discussed above with respect to claim 1, the proposed combination of Kurokawa *et al.* and Leung *et al.* is likewise deficient with respect to claim 21.

Claim 4 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Kurokawa *et al.*-Leung *et al.* combination, in further view of Aihara *et al.* (U.S. Patent No. 6,011,634). Aihara *et al.* is applied in connection with the feature of claim 4 in which the failure of the document obtaining section to obtain a document causes the output section to provide an output indicative of the absence of the document. The office action references Aihara *et al.*'s disclosure at col. 22, line 60 *et seq.* of causing a display module to display an error message when a document to be erased cannot be found. Applicant respectfully submits that Aihara *et al.*'s disclosure of an error message is in the context of an erasing operation and would not have suggested the feature of claim 4. In any event, Aihara *et al.* does not remedy the deficiencies of Kurokawa *et al.* and Leung *et al.* with respect to claim 1 (from which claim 4 depends).

Claims 5-12 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Kurokawa *et al.*-Leung *et al.* combination, in further view of Jeran *et al.* (U.S. Patent No. 6,628,412). Jeran *et al.* is cited for its disclosure of printing information such as a version number or a code for authorization on a document. When the document is later scanned,

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the information can be used to track the document or to determine whether a particular person has permission to copy the document. These teachings are in a different context than the subject matter of claims 5-12. In *Jeran et al.*, the information is associated with a document in a person's possession and is used to track the document or to determine whether that document can be copied. In the context of claim 8, for example, the presence/absence of approval information is used to determine whether to output a document. As such, Applicant respectfully submits that *Jeran et al.* does not disclose or suggest the subject matter of claims 5-12. In addition, *Jeran et al.* does not remedy the deficiencies of *Kurokawa et al.* and *Leung et al.* with respect to claim 1 (from which claims 5-12 depend).

Claim 23 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over *Kurokawa et al.* in view of *Leung et al.*, further in view of *Fukushima et al.* (U.S. Patent No. 5,293,256), and further in view of *Bubien, Jr. et al.* (U.S. Patent No. 5,638,433). The document management system of claim 23 includes a document management device along the lines of claim 1. As such, the *Kurokawa et al.* and *Leung et al.* documents are deficient with respect to the document management device features of claim 23 for the reasons set forth above with respect to claim 1. *Fukushima et al.* and *Bubien et al.* do not remedy the deficiencies of *Kurokawa et al.* and *Leung et al.* in this regard and for this reason alone claim 23 is believed to be allowable over the proposed combination. In addition, Applicant does not find either *Fukushima et al.* or *Bubien, Jr. et al.* to disclose or suggest, among other things, the concept of selecting from a plurality of telephone numbers by comparing these numbers to the number of the device making the call as further specified in claim 23. For this additional and independent reason, claim 23 is believed to be allowable over the proposed combination.

Claim 24 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over *Kurokawa et al.* in view of *Leung et al.*, further in view of *Fukushima et al.* (U.S. Patent No. 5,293,256), further in view of *Bubien, Jr. et al.* (U.S. Patent No. 5,638,433), and further in view of *Müller et al.* (U.S. Patent No. 6,356,541). *Müller et al.* discloses storing service fee (toll) data for a number of internet service providers. However, even assuming this teaching could somehow be applied to the proposed four-way combination of *Kurokawa et al.*; *Leung et al.*; *Fukushima et al.*; and *Bubien Jr. et al.*, the claimed features of, for example, the document

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management device recited in claim 24 would still lacking. Consequently, claim 24 is believed to be allowable.

New claims 25-32 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added.

Claim 25 is directed to a document management device, comprising a memory section for storing documents each of which has an identification number, an input section for receiving an image including an identification number identifying a requested document and summary information of the requested document, an output section and a control section. The control section includes an extracting section for extracting the identification number and the summary information of the requested document from the image received by the input section, a document obtaining section which retrieves from the memory section a document whose identification number corresponds to the extracted identification number, and a judging section which uses the extracted summary information to determine whether to output the retrieved document via the output section. Applicant respectfully submits that the applied documents do not teach or suggest, among other things, an input section that receives an image as claimed. Consequently, claim 25 and its dependent claims are believed to be allowable.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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